Appl. No. 10/731,655
Amdt. dated October 3, 2007

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REMARKS/ARGUMENTS

Claims 1-26 are rejected under 35 U.S.C. 112, 2nd paragraph.

Claims 1-26 are rejected under 35 U.S.C 101 as failing to provide a useful, concrete, and tangible result.

Claims 1-3, 7, 9-14, 18, 20, 2, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Implementing Oracle Workflow, Published in 1999, known hereafter as Mathieson in view of US 2001/0002485, known hereafter as Bisbee.

Claims 4-6, 15-17, and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mathieso in view of Bisbee in further view of "Integrating XML and Databases:" known hereafter as Bertino.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mathieson in view of Bisbee in view of Official Notice.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mathieson in view of Bisbee in view of Bertino and Official Notice.

Claim Rejections Under 35 U.S. C. § 103(a)

Applicants respectfully traverse the rejections to claims 1-26 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Mathieson in view of Bisbee, Bertino, and Official Notice. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Mathieson with the teachings of Bisbee, Bertino, and Official Notice.

Applicants, however, respectfully submit that a prima facie case of obviousness has not been established by the evidence presented in the Office Action. In order to establish a prima facie showing of obviousness, three requirements must be satisfied: all limitations of a pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or motivation in the art for the ordinarily skilled artisan to combine the limitations;

and there must be a reasonable expectation of success in making such a combination. (M.P.E.P.
§ 2143).

Applicants respectfully submit that Mathieson, Bisbee, and Bertino, either
individually or in combination, fail to teach or suggest one or more of the claim limitations
recited in each of claims 1-26.

Claim 1

Applicants respectfully submit that Matheison and Bisbee, either individually or
in combination, fail to teach or suggest each and every claim limitation recited in amended claim
1.

For example, amended claim 1 recites creating an electronic record that includes
transaction data from a database transaction prior to committing the associated database
transaction to a database. The Office Action fails to establish that Matheison and Bisbee, either
individually or in combination, disclosure the above-recited limitation.

Page 2 of Mathieson discloses that once a document has been created in
Mathieson using the web form of FIG. 1, clicking on the "SEND" button initiates the workflow
process. (Mathieson: Page 2, first sentence). Thus, the documents in Mathieson (i.e., the alleged
equivalent to the electronic record recited in claim 1) are created from data entered into the web
form of FIG. 1 prior to initiating the workflow process.

The Office Action states that the "START" node of FIG. 3 of Mathieson is
equivalent to initiating a database transaction as recited in claim 1. Thus, the Office Action has
set forth that the documents in Mathieson are created (e.g., from data in FIG.1) before any
alleged database transactions are intiated (e.g., the "START" node of FIG. 3 initiates the
workflow process, and Mathieson discloses that once a document has been created clicking on
the "SEND" button initiates the workflow process). Therefore, creating documents before
initiating a workflow process is substantially different from claim 1 that recites that a database
transaction is initiated and an electronic record is created that includes transaction data from the
database transaction prior to committing the database transaction to a database.

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The electronic record recited in claim 1 is created <u>from</u> transaction data from the database transaction. Accordingly, the Office Action clearly fails to demonstrate that Mathieson discloses the feature recited in claim 1 of "creating an electronic record that includes transaction data from the database transaction" because Mathieson creates documents (e.g., FIG. 1) <u>before</u> initiating the workflow process at the "START" node of FIG. 3 which the Office Action identifes as when database transactions are initiated, and not <u>from</u> transaction data from a database transaction as recited in claim 1.

Moreover, Applicants respectfully submit that Mathieson fails to teach or suggest that any such documents are created <u>prior to committing the associated database transaction</u> to a database as recited in claim 1.

Thus, Applicants respectfully submit that Mathieson fails to teach or suggest each and every claim limitation recited in claim 1. Applicants further submit that Bisbee fails to cure the above discussed deficiencies that Mathieson fails to teach or suggest creating an electronic record that includes transaction data from a database transaction prior to committing the associated database transaction to a database as recited in claim 1. Bisbee fails to teach or suggest the features recited in claim 1 of "initiating a database transaction" and "creating an electronic record that includes transaction data from the database transaction prior to committing the associated database transaction to the database."

Amended claim 1 further recites committing a database transaction associated with an electronic record to a database in response to receiving an electronic signature as recited in claim 1. The Office Action acknowledges that Mathieson fails to disclose the above recited feature. The Office Action attempts to rely on Bisbee's alleged disclosure of accepting documents for storage after all business rules have been satisfied. However, Applicants respectfully submit that simply providing storage of electronically signed documents in Bisbee is substantially different from committing a database transaction associated with an electronic record to a database in response to receiving an electronic signature as recited in claim 1.

The Office Action fails to demonstrate where Bisbee discloses that a database transaction is initiated and then committed in response to receiving an electronic signature for an electronic record created from transaction data from the database transaction. Accordingly,

Applicants respectfully submit that Mathieson and Bisbee, either individually or in combination, fail to teach or suggest each and every claim limitation as recited in claim 1. Thus, Applicants respectfully submit that claim 1 is allowable over the cited references.

Claims 2-26

Applicants respectfully submit that independent claims 12, 19, and 26 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants respectfully submit that dependent claims 2-11, 13-18, and 20-25 that depend directly and/or indirectly from the independent claims 1, 12, and 19 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further respectfully submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

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